



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,262	01/16/2004	Kevin Sullivan	JPC-011 D1	5705
70813	7590	04/07/2008	EXAMINER	
GOODWIN PROCTER LLP 901 NEW YORK AVENUE, N.W. WASHINGTON, DC 20001			LIVERSEDGE, JENNIFER L	
			ART UNIT	PAPER NUMBER
			3692	
			NOTIFICATION DATE	DELIVERY MODE
			04/07/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

AAAlpha-Kpetewama@goodwinprocter.com
bhenry@goodwinprocter.com
patentdc@goodwinprocter.com

Office Action Summary	Application No.	Applicant(s)	
	10/758,262	SULLIVAN, KEVIN	
	Examiner	Art Unit	
	Jennifer Liversedge	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37,38,40-45 and 47-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37,38,40-45 and 47-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/18/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for continued examination of Application 10/758,262 filed on January 18, 2008.

The amendment contains previously presented claims: 38, 40-43, 45 and 47-50.

The amendment contains amended claims: 37 and 44.

Claims 1-36, 39, 46 and 51-52 have been canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 37-38, 40-45 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,070,153 to Simpson (further referred to as Simpson), in view of "AmEx takes the cobranding plunge" by Dee Ann Maki (further referred to as

Maki) and further in view of “The new cobrand wisdom: mine your backyard” in Credit Card News (further referred to as Credit Card News).

Regarding claim 37, Simpson discloses a computerized method for implementation of multiple accounts, wherein the multiple accounts include at least one card payment instrument account from a card issuer and at least one investment account from a financial institution, wherein a recipient of an offer for multiple accounts accepts the offer for multiple accounts and becomes an approved cardholder (columns 1-6), the method comprising:

Establishing the card payment instrument account through the card issuer for the approved cardholder in response to the acceptance, wherein the card payment instrument account includes a reward feature available to the cardholder (Figures 1 and 3; column 1, lines 10-25 and lines 45-63; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

Automatically creating the investment account for the approved cardholder through the financial institution in response to the acceptance (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Linking the card payment instrument account from the card issuer to the investment account from the financial institution (Figure 1; column 2, lines 30-41; column 4, lines 27-37; column 6, lines 19-27);

Implementing the reward feature by tracking expenditures made through the card payment instrument account and calculating a monetary reward amount in relation to

the tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28); and

Depositing the monetary reward amount generated by the reward feature into the investment account at a predetermined time interval (Figure 3; column 1, lines 45-63).

Simpson does not disclose wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer. However, Maki discloses wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer (page 1, paragraph 2; page 4, Figure of cobranded credit card). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the use of a credit card wherein a reward feature is implemented through partnership with another organization as disclosed by Simpson to adapt issuing a credit card that bears partnership organizations on the card as disclosed by Maki. The motivation would be that co-branding a credit card by including the names of participating organizations on the card, rather than just one organization in the partnership, builds customer use in using the card by providing visual queues as to the benefit of the using the card. When a user is preparing to pay for a purchase and opens their wallet and sees, for example, three credit cards, the credit card with a visual reminder that using that card will result in a deposit into one's investment account based on the purchase value will inspire the purchaser to select that card for the purchase over a card which offers no specific and tangible reward. Building loyalty and encouraging use is the motivation behind the use of co-branded credit cards.

Neither Simpson nor Maki disclose wherein the funding of the reward feature of shared between the financial institution and the card issuer. However, Credit Card News discloses wherein the funding of the reward feature of shared between the financial institution and the card issuer (pages 3 and 4 at paragraphs as marked on reference). It would be obvious to modify the providing of cobranding credit cards wherein each partners name is on the card as disclosed by Simpson and Maki to adapt sharing the funding of the reward feature as disclosed by Credit Card News. The motivation would be that both parties benefit from the cobranding experience and from having their names on the credit card and therefore it would make business sense for the both benefiting partners to share in the funding of the rewards made available to the consumers for using the co-marketed card.

Regarding claims 44, Simpson discloses a computerized method for establishing and implementing multiple accounts, wherein the multiple accounts include at least one card payment instrument account from a card issuer and at least one investment account from a financial institution (columns 1-6), the method comprising:

Simultaneously offering multiple accounts including the card payment instrument account through the card issuer and the investment account from the financial institution (column 2, lines 30-38; column 3 line 50-column 4, line 53; column 6, lines 19-26);

When a recipient of an offer for multiple accounts accepts the offer for multiple accounts, establishing the card payment instrument account in response to the acceptance, wherein the card payment instrument account includes a reward feature

available to the recipient (Figures 1 and 3; column 1, lines 10-25 and lines 45-63; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

Automatically creating the investment account in response to the acceptance (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Implementing the reward feature by tracking expenditures made through the card payment instrument account and calculating a monetary reward amount in relation to the tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28); and

Depositing the monetary reward amount generated by the reward feature into the investment account at predetermined time intervals (Figure 3; column 1, lines 45-63).

Simpson does not disclose wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer. However, Maki discloses wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer (page 1, paragraph 2; page 4, Figure of cobranded credit card). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the use of a credit card wherein a reward feature is implemented through partnership with another organization as disclosed by Simpson to adapt issuing a credit card that bears partnership organizations on the card as disclosed by Maki. The motivation would be that co-branding a credit card by including the names of participating organizations on the card, rather than just one organization in the

partnership, builds customer use in using the card by providing visual queues as to the benefit of the using the card. When a user is preparing to pay for a purchase and opens their wallet and sees, for example, three credit cards, the credit card with a visual reminder that using that card will result in a deposit into one's investment account based on the purchase value will inspire the purchaser to select that card for the purchase over a card which offers no specific and tangible reward. Building loyalty and encouraging use is the motivation behind the use of co-branded credit cards.

Neither Simpson nor Maki disclose wherein the funding of the reward feature of shared between the financial institution and the card issuer. However, Credit Card News discloses wherein the funding of the reward feature of shared between the financial institution and the card issuer (pages 3 and 4 at paragraphs as marked on reference). It would be obvious to modify the providing of cobranding credit cards wherein each partners name is on the card as disclosed by Simpson and Maki to adapt sharing the funding of the reward feature as disclosed by Credit Card News. The motivation would be that both parties benefit from the cobranding experience and from having their names on the credit card and therefore it would make business sense for the both benefiting partners to share in the funding of the rewards made available to the consumers for using the co-marketed card.

Regarding claims 38 and 45, Simpson discloses allowing independent funding of the investment account by the cardholder (Figures 1 and 3; column 1, lines 54-67;

Art Unit: 3692

column 2, lines 17-22; column 4, lines 13-19; column 4, line 63-column 5, line 5; column 5, lines 41-59).

Regarding claims 40 and 47, Simpson discloses wherein the card payment instrument account includes at least one of a credit card account, a stored value card account, a debit card account, and a multi-featured credit on a debit card account (column 1, lines 21-25 and 45-53; column 2, lines 29-49).

Regarding claims 41 and 48, Simpson discloses wherein the investment account includes at least one of a mutual fund account, a stock account, an individual retirement account, a 401(k) plan account, a savings account, a certificate of deposit account, a money market fund, and an employee stock purchase account (column 1, lines 21-25 and 45-53).

Regarding claims 42 and 49, Simpson discloses calculating the monetary reward amount each month as a percentage of net purchases in the card payment instrument account (column 1, lines 54-59; column 2, lines 50-66; column 4, lines 45-57; column 5, lines 25-30).

Regarding claims 43 and 50, Simpson discloses transferring the monetary reward amount to the investment account at least once a year (column 1, lines 54-59; column 2, lines 50-66; column 4, lines 45-57; column 5, lines 25-30).

Response to Arguments

Applicant has argued that Simpson fails to disclose a payment card instrument bearing the name of the financial institution and the name of the card issuer and that Simpson fails to disclose establishing an agreement between the financial institution and the card issuer wherein funding of the reward feature is shared between the financial institution and the card issuer. However, as set forth in the rejection above, Maki discloses a co-branded credit card which bears the names of co-branding parties. Further Credit Card News discloses the shared payment of rewards amongst co-branding parties.

Applicant also argues that Simpson fails to show the simultaneous offering of multiple accounts including the card payment instrument through the card issuer and the investment account from the financial institution and automatically establishing the card payment instrument in response to the acceptance and creating the investment account in response to the acceptance. Examiner respectfully disagrees. Simpson discloses these features as detailed in the rejection above. For example, in column 2, lines 30-40 and column 6, lines 19-28, Simpson shows a simultaneous offering of multiple accounts including a card payment instrument and an investment account, whereby acceptance of the credit card offer results in the establishment of the card and a financial account. Separate accounts are established as the multiple accounts while offered simultaneously include a credit card payment instrument from a card issuers and an investment account from a financial institution (column 3, lines 21-26 discusses

as an alternative that the card issuer and the financial institution could be one and the same). Column 3, line 65 – column 4, line 18 further discusses the simultaneous offering of multiple accounts.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

Art Unit: 3692

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

Art Unit 3692

/Kambiz Abdi/

Supervisory Patent Examiner, Art Unit 3692